

REMARKS

Applicants submit this Reply in response to the non-final Office Action mailed on February 11, 2009. Claims 29-47 are submitted for examination, of which claim 29 is the sole independent claim. By this Reply, Applicants have amended claims 29 and 35-37. No new matter has been added.

In the Office Action, the Examiner rejected claims 36 and 37 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention; rejected claims 29, 31, 32, 38, and 44-47 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Pat. App. No. 5022822 ("Takahashi") in view of U.S. Pat. No. 4,383,131 ("Clabburn") and U.S. Pat. No. 3,352,962 ("Brown") and further in view of Merriam-Webster OnLine Dictionary ("Merriam-Webster"); rejected claims 30 and 33-37 under § 103(a) as being unpatentable over Takahashi, Clabburn, Brown, and Merriam-Webster, and further in view of *Extrusion - The Definitive Processing Guide and Handbook* ("Giles"); and rejected claims 39-43 under § 103(a) as being unpatentable over Takahashi, Clabburn, Brown, and Merriam-Webster, and further in view of U.S. Pat. No. 5,283,392 ("Ooshima").

In this Reply, Applicants have amended independent claim 29 to recite, among other things:

A process for manufacturing an elastomeric sleeve of a joint for electrical cables, . . . said process comprising the steps of: . . . introducing said electric field control element and said stress control screens into a mould provided for moulding said electrical insulating element made of an electrical insulating material; [and] prior to introducing said electric field control element and said stress control

screens into said mould, providing said electric field control element and said stress control screens on a supporting element

Support for this amendment can be found in Applicants' specification at least at page 19, line 35-page 20, line 4 and Figures 2 and 5.

Applicants respectfully traverse all pending rejections for at least the reasons discussed below.

Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 36 and 37 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the Examiner, "Claims 36 and 37 recite the phrase 'a verse of filling said insulating material into said mold.' It is unclear what is meant by 'a verse' within the context of the claim. . . .

[A]ssuming that 'verse' means 'direction,' claim 36 would be a duplicate of claim 35. Claim 37, which depends on claim 35, would not make sense . . ." Office Action at 2.

In response, Applicants have amended claims 35-37 to clarify those claims.

Amended claim 35 now recites, "The process according to Claim 29, wherein a path of filling said insulating material into said mould corresponds to a path of introduction of said supporting element into said mould." Additionally, amended claim 36 now recites, "The process according to Claim 35, wherein a direction of filling of said insulating material into said mould corresponds to a direction of introduction of said supporting element into said mould," and amended claim 37 now recites, "The process according to Claim 35, wherein a direction of filling of said insulating material into said mould is opposite to a direction of introduction of said supporting element into said mould."

Support for these amendments can be found at least in Figures 7 and 12. For example, in both figures it is evident that the “path of filling of said insulating material,” (C), and the “path of introduction of said supporting element,” (A) and (E), respectively, are the same. However, in Figure 7, the “direction of filling of said insulating material,” (C), is opposite to the “direction of introduction of said supporting element,” (A), while, in Figure 12, the “direction of filling of said insulating material,” (C), corresponds to the “direction of introduction of said supporting element,” (E).

Accordingly, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

Rejections Under 35 U.S.C. § 103(a)

Applying 35 U.S.C. § 103(a), the Examiner rejected claims 29, 31, 32, 38, and 44-47 as being unpatentable over Takahashi in view of Clabburn and Brown and further in view of Merriam-Webster; rejected claims 30 and 33-37 as being unpatentable over Takahashi, Clabburn, Brown, and Merriam-Webster, and further in view of Giles; and rejected claims 39-43 as being unpatentable over Takahashi, Clabburn, Brown, and Merriam-Webster, and further in view of Ooshima. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, none of Takahashi, Clabburn, Brown, Giles and Ooshima, alone or in any combination, teaches or suggests every feature of Applicants' claims. Specifically, none of the references cited by the Examiner teaches or suggests "prior to introducing said electric field control element and said stress control screens into said mould, providing said electric field control element and said stress control screens on a supporting element," as recited in amended independent claim 29.

Takahashi teaches a process for manufacturing a sleeve for a joint between electrical cables. The reference discloses, "An internal semiconductor layer 15, an insulating layer 17 and an external semiconductor layer 19 are co-extruded and molded on the outer circumference of a central conductor 13 composed of a pipe made of a metal or a torsion wire having a circular cross section." Takahashi at Abstract. Since the electric field control layer, insulating layer, and external semiconductor layer in Takahashi are co-extruded on to a supporting element, and, thus, all formed in the same mould at the same time, that reference necessarily does not teach or suggest placing an electric field control element and a pair of stress control screens on a supporting element "prior to introducing the field control and stress elements into said mould." Similarly, no other reference cited by the Examiner teaches or suggests, "prior to introducing said electric field control element and said stress control screens into said mould, providing said electric field control element and said stress control screens on a supporting element."

Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of amended independent claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi, Clabburn, Brown, Giles and Ooshima.

Moreover, claims 30-47 depend from independent claim 29 and, thus, contain all the elements and recitations thereof. As a result, dependent claims 30-47 are allowable at least due to their corresponding dependence from independent claim 29.

Claim Scope

It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicants' undersigned attorney at (404) 653-6435.

Applicants respectfully submit that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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Dated: May 7, 2009